



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

ch

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/908,966	07/19/2001	Christopher McCormick	ELT-002 (6281/6)	6828

21323 7590 05/02/2003

TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON, MA 02110

EXAMINER

SUHOL, DMITRY

ART UNIT PAPER NUMBER

3712

DATE MAILED: 05/02/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/908,966

Applicant(s)

MCCORMICK ET AL.

Examiner

Dmitry Suhol

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-6, 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Englishtown.com (dated 1/18/99). Englishtown.com (online language school) has been in public use since the mid to late 90's utilizing the claimed method steps to match students and tutors for instruction over a network/Internet.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman et al (US Publication 2002/0013836). Friedman discloses a method for facilitating private instruction over a network containing most of the elements of the claims including, with reference to claim 1, receiving a student profile from each student

(figure 3, element 32), adding each student who registers to a list of students unassigned to a teacher (page 1, paragraph 15) where a memory/database is read onto list, assigning a teacher capable of teaching a given private course (figure 3, element 41). A teacher assigned to a student being in a different time zone than that student, as required by claim 5, is described in page 1, paragraph 15, where it states that a tutor computer may be located anywhere. Communicating between an assigned teacher and a student, as required by claims 6-7, is described on pages 4-5 in paragraphs 40 and 46 respectively. Profile information identifying preferred a time of day and a preferred day of the week for conducting a discussion session, as required by claim 8, is described in page 4, paragraph 40 under "Tutor by Appointment". Opening a voice channel between a student and teacher, as required by claim 9, is described on page 5, paragraph 50. Opening a text channel for discussion between a student and teacher, as required by claim 10, is described on page 5, paragraph 50. A private course being a course in a language that is foreign to a student, as required by claim 11, is described on page 1, paragraph 12.

Although Friedman discloses most of the elements of the claims, the reference fails to explicitly teach enabling access to a list of students and profile information of the students by each teacher able to teach the course as required by claim 1, placing each student in the list of students in an order based upon an enrollment date of each student as required by claim 4, a language being English as required by claim 12. However, it is common practice for a perspective teacher to have a limited security access (i.e. read only or partial access) to a database of perspective students that are registering for

classes at an educational facility where the teacher teaches (i.e. US Patent Publication 2003/0039948 page 7, paragraph 0060). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to grant a perspective teacher/tutor read only/partial access to profile information of perspective students for the purposes of gathering information.

Furthermore the order of placement of a student on an enrollment list based upon the enrollment/registration date is well known in the educational arts (i.e. colleges class registration is completely based upon the enrollment date of a particular student). Therefore it would have been obvious to place a student on a registration list based upon an enrollment date for the purpose of providing a fair and honest service based on "first come first serve methodology".

A foreign language being English would have been obvious since a majority of the world does not speak English and since there is large population in the U.S. where English is a second language and Friedman specifically teaches that his invention contemplates the teaching of a second language (paragraph 12, page 1).

Regarding claims 2-3, although Friedman teaches matching of a student and teacher by an automated process, it would have been obvious to use the weighted criteria of his system and match the two parties by an administrator or by the teacher themselves for the purpose of incorporating a human element with objective reasoning into the process, especially since administrators and teachers/tutors have been matching tutoring sessions with students themselves prior to the advent of a computer.

Art Unit: 3712

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ds
April 25, 2003

A handwritten signature in black ink, appearing to read 'Derris H. Banks', with a long horizontal line extending to the right.

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700